

1 REMARKS

2 Claims 1-33 remain pending in the present application. No claims are currently amended.
3 However, a complete listing of the most up-to-date claims is provided for the Examiner's
4 convenience, as suggested under the topic "Revised Amendment Practice" on the U.S. Patent and
5 Trademark Office web site.

6 Claims Objected To

7 Claims 18-23 are objected to because Claim 18 recites "said *data are* already in the
8 compressed format." (Emphasis added.) The Office Action states that the word "data" is a singular
9 noun, and not plural. However, applicants respectfully point out that the word "data" is formally the
10 plural of the word "datum" (Merriam-Webster's Collegiate Dictionary, 10th Edition,
11 Merriam-Webster, Inc., 2002, pg. 293). Thus, the word "data" should be used with the plural verb
12 form "are" rather than the singular verb form "is." Accordingly, applicants respectfully request that
13 the objection to Claims 18-23 be withdrawn by the Examiner.

14 Claims Rejected under 35 U.S.C. § 112

15 Claims 18-23 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with
16 the written description requirement. Specifically, the Office Action indicates that support for a
17 portion of limitation (d) of Claim 18 is not found in the specification on page 3, line 30 through
18 page 4, line 2, and page 4, line 33 through page 5, line 1, as indicated by the applicants in the
19 preliminary amendment filed with the continued prosecution application. Claim 18 recites in
20 step (d): "converting said data representing the selected image into a compressed format unless said
21 data are already in the compressed format." Support for the specific portion of Claim 18 that is in
22 question is provided in the specification in regard to Table 4, as follows:

23 In order to perform autoscanning, it is necessary to negotiate the capabilities of the image
24 acquisition device prior to initiating the scanning process. Since it is desired that the
25 autoscanning option require minimal user input, the capabilities of the image acquisition
26 device are preferably negotiated based on predetermined criteria. These criteria include a
predetermined resolution and a predetermined JPEG compression level. (Specification,
pg. 47, line 33 through pg. 48, line 3).

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1 Thus, the data can be provided by the image acquisition device in JPEG compressed format. In that
2 case, the data output from the image acquisition device are already in compressed format (i.e., in
3 JPEG format). Accordingly, applicants respectfully request that the rejection of Claims 18-23 under
4 35 U.S.C. § 112, first paragraph, be withdrawn.

5 Claims Rejected under 35 U.S.C. § 102(a)

6 Claims 1-3, 6, 9, 10, 12, 13, 15-17, 24, 25, and 27-31 are rejected under 35 U.S.C. § 102(a) as
7 being anticipated by Camarda et al., "Special Edition Using Microsoft Word 2000," Pearson
8 Education, Inc., January 8, 1999 (hereinafter referred to as Camarda). Concurrently submitted with
9 this response is a Declaration Under 37 CFR 1.131 of all of the joint inventors swearing behind the
10 Camarda reference. Also submitted is evidence showing that the invention was conceived and
11 actually reduced to practice prior to the publication date of the cited reference. This evidence
12 includes the enclosed documents entitled, "Support for TWAIN devices" (Exhibit A), "Twain
13 Feasibility Study – Final Report" (Exhibit B), and "TWAIN support in Office" (Exhibit C).
14 Applicants believe that the declaration and these documents make clear that all of the elements of
15 each claim of the application were conceived and reduced to practice before the publication date of
16 the cited art. Accordingly, the rejection of the above claims under 35 U.S.C. 102(a) should be
17 withdrawn.

18 Even apart from applicants' declaration, applicants note that Camarda does not disclose or
19 suggest all of the elements of applicants' claims. For example, with regard to all of the independent
20 claims, Camarda does not disclose or suggest that the data representing the image are not saved to a
21 permanent file before the data are communicated into the document. Instead, Carmarda discloses
22 only that Word 2000 enables a user to insert an image "without using an additional applet such as
23 Microsoft Photo Editor" (Camarda, pg. 6, 1st full paragraph). An applet such as Microsoft Photo
24 Editor would enable a user to enhance or modify an acquired image, so omitting the applet only omits
25 the ability to enhance or modify the acquired image. Omitting the ability for a user to enhance or
26 modify an acquired image does not disclose or suggest that the data representing the acquired image
27 are not saved to a permanent file before being introduced into the document. Before applicants'
28 invention, only image data from a previously saved file could be introduced into a document.
29 Accordingly, the rejections under 35 U.S.C. 102(a) should be withdrawn, notwithstanding the
30 declaration.

1 Claims Rejected Under 35 U.S.C. 103(a) over Camarda in view of Sobol

2 Claims 4, 5, 18, 21-23, 32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable
3 over Camarda in view of U.S. Patent No. 5,907,665 (Sobol et al., hereinafter referred to as Sobol).
4 However, because applicants have sworn behind Camarda, Carmarda is not available as a reference.
5 The remaining cited art does not disclose or suggest all of the elements of the rejected claims.
6 Therefore, *prima facie* obviousness has not been established. Accordingly, the rejection of Claims 4,
7 5, 18, 21-23, 32, and 33 under 35 U.S.C. 103(a) should be withdrawn.

8 Claims Rejected Under 35 U.S.C. 103(a) over Camarda in view of Photoshop

9 Claims 7, 8, 19, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over
10 Camarda in view of "Mastering Photoshop 5 for the Web," Matt Straznitskas, Sybex, Inc., 1998
11 (hereinafter referred to as Photoshop). However, as indicated above, Camarda is not available as a
12 reference because of applicants' declaration, and the other prior art does not disclose or suggest all of
13 the elements of the rejected claims. Again, *prima facie* obviousness has not been established.
14 Accordingly, the rejection of Claims 7, 8, 19, and 31 under 35 U.S.C. 103(a) should be withdrawn.

15 Claims Rejected Under 35 U.S.C. 103(a) over Camarda in view of Johnson

16 Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Camarda in view of
17 "Troubleshooting and Configuring the Windows NT/95 Registry," Clayton Johnson, Sams Pub.,
18 1997. (hereinafter referred to as Johnson). However, as indicated above, in view of the declaration
19 submitted herewith, Camarda is not available as a reference. Further, as discussed in the preliminary
20 amendment to this CPA, Johnson and the remaining prior art do not disclose or suggest all of the
21 elements of the rejected claims. Therefore, *prima facie* obviousness has not been established, and the
22 rejection of Claim 11 under 35 U.S.C. 103(a) should be withdrawn.

23 Claims Rejected Under 35 U.S.C. 103(a) over Camarda in view of Arakawa

24 Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Camarda in view of
25 Arakawa (U.S. Patent No. 5,845,076, hereinafter referred to as Arakawa). However, as indicated
26 above, Camarda is not available as a reference, because of applicants' declaration. Further, Arakawa
27 and the remaining prior art do not disclose or suggest all of the elements of the rejected claims. Thus,
28 the rejection of Claim 14 under 35 U.S.C. 103(a) should be withdrawn.

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1 Claims Rejected Under 35 U.S.C. 103(a) over Camarda in view of Sobol and Hearn

2 Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Camarda in view of
3 Sobol, and further in view of Hearn et al. (U.S. Patent No. 6,154,756, hereinafter referred to as
4 Hearn). However, as indicated above, Camarda is not available as a reference, in consideration of the
5 declaration submitted herewith. Further, Hearn and the remaining prior art do not disclose or suggest
6 all of the elements of the rejected claims. Therefore, *prima facie* obviousness has not been
7 established. Accordingly, the rejection of Claim 20 under 35 U.S.C. 103(a) should be withdrawn.

8 Claims Rejected Under 35 U.S.C. 103(a) over Camarda in view of Hearn

9 Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Camarda in view of
10 Hearn. However, because applicants have sworn behind it, Camarda is not available as a reference.
11 Further, Hearn and the remaining prior art do not disclose or suggest all of the elements of the
12 rejected claims. Therefore, this rejection of Claim 26 under 35 U.S.C. 103(a) should be withdrawn.

13 In view of the preceding remarks and the declaration swearing behind Camarda that is
14 submitted with this response, it will be apparent that the claims in this case define a novel and non-
15 obvious invention, and that the application is in condition for allowance and should be passed to issue
16 without further delay. Should any further questions remain, the Examiner is invited to telephone
17 applicant's attorney at the number listed below.

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19 Respectfully submitted,

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21
22 Ronald M. Anderson
23 Registration No. 28,829

24 I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed
25 envelope as first class mail with postage thereon fully prepaid addressed to: Commissioner for Patents, P.O.
26 Box 1450, Alexandria, VA 22313-1450, on December 9, 2003.

27 Date: December 9, 2003

28 RMA/TRM:klp

29 Enclosure

30 Declaration Under 37 C.F.R. 1.131 (with Exhibits A, B, and C)

